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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,042	08/29/2005	Harold Russell Motson	118989-05017145	5681
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/525,042

**Applicant(s)**

MOTSON ET AL.

**Examiner**

MOHAMMAD R. ASDJODI

**Art Unit**

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date 07/28/08
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

*The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:*

***A person shall be entitled to a patent unless –  
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.***

Claims 1, and 7-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Romack et al. (US 6,258,766).

Regarding Claims 1, and 7-8, Romack et al. teach a dry cleaning method and composition, for treating, or dry cleaning, textile material; [Abstract], comprising a liquid mixture of CO<sub>2</sub>; [C.1, L.63 - C.2, L.5], conditioning agent as branched fatty alcohols such as isotridecyl alcohol ethoxylate (RHODASURF DA-63™) by the amount of 0.1-5%; [C.4, L.23, C.3, L.15-40].

Claims 11, 12, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Romack et al. (US 6,258,766).

Regarding claim 11, Romack et al. teach a dry cleaning method and composition based on liquid CO<sub>2</sub> including 0.1-5% of a cleaning medium such as methyl esters with MW≤750 (e.g. dimethyl succinate); [C.2, L.60-65, C.3, L.21-22, C.4, L.1], and polyalkoxylated fatty acids; [C.4, L.25-30].

Regarding Claims 12, and 15, Romack et al. teach a dry cleaning method and composition wherein cleaning medium is free of detergent surfactants wherein the

dimethyl succinate is a non detergent surfactant; [C.3, L.26], and enzymes, fragrances, and whiteners; [C.5, L.60-65].

Claims 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Romack et al. (US 6,258,766).

Regarding claims 16-18, Romack et al. teach a dry cleaning method and composition, for treating (conditioning), textile material; [Abstract], comprising a liquid mixture of CO<sub>2</sub>; [C.1, L63 - C.2, L.5], conditioning agent as branched fatty alcohols such as isotridecyl alcohol ethoxylate (RHODASURF DA-63™) by the amount of 0.1-5%; [C.4, L.23, C.3, L.15-40], which does not contain cleaning additives.

Claims 20, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Romack et al. (US 6,258,766).

Regarding Claims 20, and 21, Romack et al. teach a dry cleaning method and composition, for treating , or dry cleaning, textile material; [Abstract], comprising a liquid mixture medium of CO<sub>2</sub>; [C.1, L63 - C.2, L.5], conditioning agent of branched fatty alcohols such as isotridecyl alcohol ethoxylate (RHODASURF DA-63™) by the amount of 0.1-5%; [C.4, L.23, C.3, L.15-40], wherein the medium does not contain cleaning additives.

With respect to rinsing the textile material with CO<sub>2</sub> based composition of Romack et al. it is elementary that the mere recitation of newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those

things to distinguish over the prior art. *In re Swinehart et al.*, 169 USPQ 226 at 229. Since the Romack et al. reference teaches all of the applicant's claimed compositional and process limitations, it is inherent that the reference article function in the same manner claimed by applicant, The textile can be washed again as a rinsing step for further cleaning purpose. The burden is upon applicant to prove that the subject matter shown to be in prior art does not possess the characteristic relied on, [MPEP 2112.01, II]. At the time of invention

### ***Claim Rejections - 35 USC § 103***

*The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:*

***(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.***

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 2-6, 9, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Romack et al. (US 6,258,766), as applied to claim 1, and further in view of Schulte et al. (US 6,558,432 B2).

Regarding claims 2-6 and 23, Romack et al. teach the basic CO<sub>2</sub> based cleaning method and composition as set forth for claim 1 above.

Romack et al. do not specifically indicate fatty alcohol branched polyalkyloxylate of formula (I) of instant claim. However, Schulte et al. teach a CO<sub>2</sub> based dry cleaning method comprising formula (I), wherein AO is the branched fatty alcohol ethoxylate,  $m=4$ ,  $R^2=H$ , and  $R^1=C1-C18$ . This satisfies the limitation of at least 50% branched alkyleneoxy residues in the instant claim; [C.7, L.45-67, C.8, L.1-20]. Schulte et al. and Romack et al. are analogous art because they are from the same field of endeavour, that of dry cleaning compositions and methods utilizing liquid carbon dioxide. At the time of invention, it would have been obvious to a person of ordinary skill in the art to use the same types of fatty alcohols of Schulte et al. (which are exactly functional equivalent) in the process of Romack et al.

Regarding claim 9, Romack teach the basic method and composition as applied to claims 8, and 1 above.

Romack et al. do not specifically indicate the multi-ester of formula (II) of instant claim, even though they teach similar multi ester ingredients; [C.3, L.23]. However, Schulte et al. teach a CO<sub>2</sub> based dry cleaning method comprising multi-ester of formula (II), wherein  $n=2$ ,  $X=COO$  and as an examples  $R^{11}=R^{12}=methyl$ ; [C.10, L.58-67, C.11, L.1-6]. This will include the  $MW \leq 750$ . At the time of invention, it would have been

obvious to a person of ordinary skill in the art to use the same types of fatty alcohols of Schulte et al. (which are exactly functional equivalent) in the process of Romack et al.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Romack et al. (US 6,258,766), as applied to claim 1, and further in view of Jureller et al. (US 5,676,705).

Regarding claim 10, Romack et al. teach the basic claimed process as set forth above regarding claim 1, except the explicit teaching that the textiles are treated with conditioning medium without any cleaning additives during a rinse cycle. However, Jureller et al. teach a method of dry cleaning fabrics using carbon dioxide as only cleaning medium during a rinse cycle; [C.21, L.15-36]. Romack et al. and Jureller et al. are analogous (or combinable) art because they are from the same field of endeavour, that of dry cleaning compositions and methods utilizing liquid carbon dioxide. At the time of invention, it would have been obvious to a person of ordinary skill in the art to use only fluid carbon dioxide for a rinse cycle, as taught by Jureller et al., in the process of Romack et al. and would have been motivated to do so in order to wash off the residues of soil and detergent from fabrics and textile.

Claims 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Romack et al. (US 6,258,766), as applied to claim 11, and further in view of Schulte et al. (US 6,558,432 B2).

Regarding claim 13, Romack et al. teach the basic CO<sub>2</sub> based cleaning method and composition as set forth for claim 11 above.

Romack et al. do not specifically indicate fatty alcohol branched polyalkyloxylate of formula (I) of instant claim. However, Schulte et al. teach a CO<sub>2</sub> based dry cleaning method comprising formula (I), wherein AO is the branched fatty alcohol ethoxylate,  $m=4$ ,  $R^2=H$ , and  $R^1=C1-C18$ . This satisfies the limitation of at least 50% branched alkyleneoxy residues in the instant claim; [C.7, L.45-67, C.8, L.1-20]. This will include the  $MW \leq 750$ . Schulte et al. and Romack et al. are analogous art because they are from the same field of endeavour, that of dry cleaning compositions and methods utilizing liquid carbon dioxide. At the time of invention, it would have been obvious to a person of ordinary skill in the art to use the same types of fatty alcohols of Schulte et al. (which are exactly functional equivalent) in the process of Romack et al.

Regarding claim 14, Romack et al. do not specifically indicate the multi-ester of formula (II) of instant claim, even though they teach similar multi ester ingredients; [C.3, L.23]. However, Schulte et al. teach a CO<sub>2</sub> based dry cleaning method comprising multi-ester of formula (II), wherein  $m=2$ ,  $X=COO$  and as an examples  $R^{11}=R^{12}=methyl$ ; [C.10, L.58-67, C.11, L.1-6]. This will include the  $MW \leq 750$ . At the time of invention, it would have been obvious to a person of ordinary skill in the art to use the same types of fatty alcohols of Schulte et al. (which are exactly functional equivalent) in the process of Romack et al.



Claims 19, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Romack et al. (US 6,258,766), as applied to claim 16, and further in view of Schulte et al. (US 6,558,432 B2).

Regarding claim 19, and 24, Romack et al. teach the basic CO<sub>2</sub> based cleaning method and composition as set forth for claim 16 above.

Romack et al. do not specifically indicate fatty alcohol branched polyalkyloxyate of formula (I) of instant claim. However, Schulte et al. teach a CO<sub>2</sub> based dry cleaning method comprising formula (I), wherein AO is the branched fatty alcohol ethoxylate, m=4, R<sup>2</sup>=H, and R<sup>1</sup>=C1-C18 hydrocarbyl group. This satisfies the limitation of at least 50% branched alkyleneoxy residues in the instant claim; [C.7, L.45-67, C.8, L.1-20]. Schulte et al. and Romack et al. are analogous art because they are from the same field of endeavour, that of dry cleaning compositions and methods utilizing liquid carbon dioxide. At the time of invention, it would have been obvious to a person of ordinary skill in the art to use the same types of fatty alcohols of Schulte et al. (which are exactly functional equivalent) in the process of Romack et al.

Claims 22, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Romack et al. (US 6,258,766), as applied to claim 20, and further in view of Schulte et al. (US 6,558,432 B2).

Regarding claims 22, and 25, Romack et al. teach the basic CO<sub>2</sub> based cleaning method and composition as set forth for claim 20 above.

Romack et al. do not specifically indicate fatty alcohol branched polyalkyloxylate of formula (I) of instant claim. However, Schulte et al. teach a CO<sub>2</sub> based dry cleaning method comprising formula (I), wherein AO is the branched fatty alcohol ethoxylate, m=4, R<sup>2</sup>=H, and R<sup>1</sup>=C1-C18. This satisfies the limitation of at least 50% branched alkyleneoxy residues in the instant claim; [C.7, L.45-67, C.8, L.1-20]. Schulte et al. and Romack et al. are analogous art because they are from the same field of endeavour, that of dry cleaning compositions and methods utilizing liquid carbon dioxide. At the time of invention, it would have been obvious to a person of ordinary skill in the art to use the same types of fatty alcohols of Schulte et al. (which are exactly functional equivalent) in the process of Romack et al.

### **Double Patenting**

*The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).*

*A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.*

*Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).*

Claims 1-3, 5 and 6 are provisionally rejected on the ground of non statutory obviousness-type double patenting as being unpatentable over claims 1, 2, and 3 of copending application No. 10/554,781. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Claim 1 corresponds to claim 1 of commonly assigned application No. 10/554,781, with the difference of the percentages of additives or conditioning agents.

Claim 2, corresponds to claim 2 of commonly assigned application No. 10/554,781, where the R<sup>1</sup>'s are identical for the range of C<sub>8</sub>- C<sub>10</sub>.

Claim 3, corresponds to claim 3 and claim 2 of commonly assigned application No. 10/554,781.

Claim 5, corresponds to claim 2 of commonly assigned application No. 10/554,781.

Claim 6, corresponds to claim 2 of commonly assigned application No. 10/554,781.

Claims 8, 9, 11, and 12, are provisionally rejected on the ground of non statutory obviousness-type double patenting as being unpatentable over claims 1, 2, and 3 of copending application No. 10/518,921. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Claim 8, corresponds to claim 10 of commonly assigned application No. 10/518,921. The motivation would have been to select a multi-ester (with MW ≤ 750) as non-surfactant cleaning agent.

Claim 9, corresponds to claim 2 of commonly assigned application No. 10/518,921.

Claims 11, and 12 corresponds to claims 1 and 10 of commonly assigned application No. 10/518,921. They overlap in scope.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-25 have been considered (which are not persuasive) but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### ***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. M. Reza Asdjodi whose telephone number is (571)270-3295. The examiner can normally be reached on Monday-Friday 8:00-5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Mark Eashoo can be reached on 571-272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark Eashoo/  
Supervisory Patent Examiner, Art Unit 1796

M. Reza Asdjodi /  
Examiner, Art Unit 1796  
11/19/08